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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/579,971

05/23/2006

Yoshihito Kawamura

2006-0785A

7359

513 7590 04/01/2011

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EXAMINER

IP, SIKYIN

ART UNIT

PAPER NUMBER

1735

NOTIFICATION DATE

DELIVERY MODE

04/01/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/579,971	KAWAMURA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sikyin Ip	1735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 2/5/2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 2,5,7,15-18,20,23,25,34-37 and 39-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,8-14,19,21,22,24,26-33 and 38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 4, 6, 8-14, 19, 21, 22, 24, 26-33, and 38 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 11/943207. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claimed Mg alloy composition and long period stacking ordered structure are included in claims of co-pending application (especially claims 1 and 3). The recited properties such dislocation density, vol. fraction, grain size are properties of composition and similar processing, which would have been inherently possessed.

Claims 1, 3, 4, 6, 8-14, 19, 21, 22, 24, 26-33, and 38 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 45-70 of copending Application No. 12/225069. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claimed Mg alloy composition and long period stacking ordered structure are included in claims of co-pending application (especially claims 45, 63, and 80). The recited properties such dislocation density, vol. fraction, grain size are properties of composition and similar processing, which would have been inherently possessed.

Claims 1, 3, 4, 6, 8-14, 19, 21, 22, 24, 26-33, and 38 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-56 of copending Application No. 11/727729. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claimed Mg alloy composition and long period stacking ordered structure are included in claims of co-pending application (especially claims 1 and 10). The recited properties such dislocation density, vol. fraction, grain size are properties of composition and similar processing, which would have been inherently possessed.

With respect the processing limitations that the invention defined in a product-by-process claim is a product, not a process. In re Bridgeford, 357 F. 2d 679, 149 USPQ 55 (CCPA 1966) and MPEP § 2113. It is the patentability of the product claimed and not of the recited process steps which must be established. See In re Brown, 459 F. 2d 531, 173 USPQ 685 (CCPA 1972).

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3, 4, 6, 12-14, 19, 21, 22, 24, 31, 32, and 33 are rejected under 35 U.S.C. 103(a) as being by Kawamura et al (PTO-1449, long-period stacking structure and hcp-Mg phase [Introduction], Mg-Zn-(Dy, Ho, Er) [Table 1]).

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Kawamura discloses melt-spun  $\text{Mg}_{97}\text{Zn}_1\text{RE}_2$  alloys ribbons (abstract). The RE includes Y, La, Ce, Pr, Nd, Sm, Eu, Gd, Tb, Dy, Ho, Er, and Yb. Kawamura does not disclose that cast Mg-Zn-(Dy, Ho, or Er) alloys have long period stacking ordered structure phase. But, since the alloy composition has anticipated the claimed composition and casting step overlapped; consequently, the long period stacking ordered structure phase as recited in the instant claims would have inherently possessed by the teachings of the cited reference. Therefore, the burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possess characteristics attributed to the claimed product.

In re Best, 195 USPQ, 430 and MPEP § 2112.01.

“Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). ‘When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.’ In re Spada, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977).”

With respect to the process limitations that the invention defined in a product-by-process claim is a product, not a process. In re Bridgeford, 357 F. 2d 679, 149 USPQ 55 (CCPA 1966) and MPEP § 2113.

Claims 8, 9, 10, 11, and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura et al as applied to claims above, and further in view of JP 05306424 (PTO-1449).

Kawamura et al discloses the features substantially as claimed as set forth in the rejection above except for hcp-Mg phase grain size, vol. fraction of long period stacking ordered structure/intermetallic compounds/precipitation, and dislocation density. However, JP 05306424 discloses Mg matrix and intermetallic compounds average grain size is limited to 5  $\mu\text{m}$  in the same field of endeavor or the analogous metallurgical art. Therefore, it would have been obvious to one having ordinary skill in the art of the cited references at the time the invention was made to limit Mg matrix grain size to less than 5  $\mu\text{m}$  as taught by JP 05306424 in order to improve/provide improve hardness (See JP 05306424 abstract and [0020]). In re Venner, 120 USPQ 193 (CCPA 1958), In re LaVerne, et al., 108 USPQ 335, and In re Aller, et al., 105 USPQ 233.

Dislocation density in long period stacking ordered structure phase is expected lower than hcp structure Mg phase because said vol. fraction of long period stacking ordered structure phase is limited not more than 50% in said Mg phase (JP 05306424, abstract).

With respect the processing limitations that the invention defined in a product-by-process claim is a product, not a process. In re Bridgeford, 357 F. 2d 679, 149 USPQ 55 (CCPA 1966) and MPEP § 2113. It is the patentability of the product claimed and not of the recited process steps which must be established. See In re Brown, 459 F. 2d 531, 173 USPQ 685 (CCPA 1972).

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura et al as applied to claims above, and further in view of USP 3334998 to Fisher.

Kawamura discloses the features substantially as claimed as set forth in the rejection above except for additional optional elements. However, Fisher discloses

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recited optional elements (col. 3, lines 1-18) to reduce crack in Mg-based alloy (col. 3, lines 54-65). It has been held that combining known ingredient having known functions, to provide a composition having the additive effect of each of the known functions is within realm of performance of ordinary skill artisan. In re Castner, 186 USPQ 213 (217). The use of conventional materials to perform their known functions in a conventional process is obvious. In re Raner, 134 USPQ 343 (CCPA 1962).

### ***Response to Arguments***

Applicant's declaration filed February 5, 2010 and arguments December 2, 2009 filed have been fully considered but they are not persuasive.

Applicants' argument in instant remarks and tests in declaration are noted. But, tests are not comparable with Kawamura teaching. The melt-spun ribbons are annealed at 573 K for 1.2 ks. There is no annealing of the melt-spun ribbon in the declaration. Kawamura in page 755 discloses

~~that the composition of the melt-spun alloy is different from the other alloys. It has been reported that the annealed Mg<sub>90</sub>Zn<sub>10</sub>Y<sub>2</sub> RS alloy consists of hcp-Mg with a novel long periodic stacking structure, resulting the improved mechanical properties. Therefore, the Mg<sub>90</sub>Zn<sub>10</sub>Y<sub>2</sub> RS~~

### **Conclusion**

This is a RCE application. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the



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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121; 37 C.F.R. Part §41.37 (c)(1)(v); MPEP §714.02; and MPEP §2411.01(B).

#### Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (571) 272-1241. The examiner can normally be reached on Monday to Thursday from 5:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica L. Ward, can be reached on (571)-272-1223.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/Sikyin Ip/  
Primary Examiner, Art Unit 1735  
March 27, 2011